

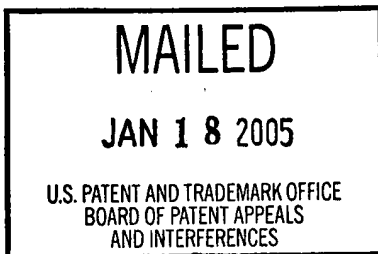
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT J. MCMILLEN,
M. CAMERON WATSON, and
DAVID J. CHURA



Appeal No. 2004-1337
Application No. 09/783,923

ON BRIEF

Before KRASS, RUGGIERO, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 154-165, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellants' invention relates to multicast transmissions in a multistage interconnect network. An understanding of the invention can be derived from a reading of exemplary claim 154 , which is reproduced in the appendix to the brief.

The reference of record relied upon by the examiner in rejecting the appealed claims is:

McMillen et al. (McMillen)	5,321,813	Jun. 14, 1994
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Claims 154-165 stand rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 86-95 of prior U.S. Patent No. 5,321,813.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 11, mailed Oct. 3, 2003) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 10, filed Jul. 16, 2003) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants argue that the substance of pending claims 154-165 do not claim the same limitations and claims 86-95 lack identity with claims 154-165. (See brief at pages 4-9.) The examiner maintains that claims 86-95 of the prior (parent) patent could be infringed by pending claims 154-165. The examiner maintains that a correlation of claim 86 of the patent to claim 162 as shown in the answer is exemplary of the literal infringement. We disagree with the examiner. The examiner maintains that those portions of claim 86 which do not have corresponding limitations in claim 162 would have been inherent in the structure of the plurality of switch nodes. (See answer at pages 4-5.) We disagree with the examiner and do not find that the examiner has shown how these limitations would have been inherently present. Additionally we note that there is a glaring difference between the present application claims and the claims of the patent in the examiner's table. Specifically, the limitations of the patent are drafted in means plus function format where the specific structure, acts and materials disclosed in the specification would be read into the claim limitations, whereas, the present claims may be interpreted as being broader than the limitations of the patent claims. Here, we find that the present claims set forth the switch nodes and nominally recite the interconnection, whereas the claims of the patent set forth the specifics of what interconnects the plurality of switch nodes. Therefore, we disagree with the examiner that the present claims are directed to the same invention, and we will not sustain the double patenting rejection.

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CONCLUSION


To summarize, the decision of the examiner to reject claim 154-165 under 35 U.S.C. § 101 is reversed.

REVERSED


ERROL A. KRASS
Administrative Patent Judge


JOSEPH F. RUGGIERO
Administrative Patent Judge

BOARD OF PATENT
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JOSEPH L. DIXON
Administrative Patent Judge

JLD/vsh

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